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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/730,325	12/08/2003	Jerome Skuba	Skuba-P1-03	2418

28710 7590 05/06/2010

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EXAMINER	
PALO, FRANCIS T	
ART UNIT	PAPER NUMBER
3644	
MAIL DATE	DELIVERY MODE
05/06/2010	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/730,325	SKUBA, JEROME	
	Examiner	Art Unit	
	Francis T. Palo	3644	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *3* MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *1/8/10 (Appeal Brief)*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-24* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-24* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *08 December 2003* is/are: a)☒ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

APPEAL BRIEF

In view of the appeal brief filed on 1/8/10, PROSECUTION IS HEREBY REOPENED. A new ground of rejection is set forth below because the previously relied on priority date (5/16/1997) of the Kawamoto '690 reference is not an anticipatory date.

To avoid abandonment of the application, appellant must exercise one of the following two options:

(1) file a reply under 37 CFR 1.111 (if this Office action is non-final) or a reply under 37 CFR 1.113 (if this Office action is final); or,

(2) initiate a new appeal by filing a notice of appeal under 37 CFR 41.31 followed by an appeal brief under 37 CFR 41.37. The previously paid notice of appeal fee and appeal brief fee can be applied to the new appeal. If, however, the appeal fees set forth in 37 CFR 41.20 have been increased since they were previously paid, then appellant must pay the difference between the increased fees and the amount previously paid.

A Supervisory Patent Examiner (**SPE**) has approved of reopening prosecution by signing below:

***.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1, 17-20 and 22 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Specifically, **claim-1** recites forming a piece including at least one member from the group subset consisting of '**spaces** for', by growing roots in the piece at at least one grower location; it is unclear what is meant by forming a piece including 'a space', by growing roots in the piece at a grower location, as claimed.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-24 are rejected under 35 U.S.C. 102(b) as anticipated by or,

in the alternative, under 35 U.S.C. 103(a),

as obvious over **Molnar** (US 5,224,290)1993.

Regarding amended independent method **claim-2**:

Molnar '290 teaches a method of forming a garden as recited in the instant claim preamble, including the claimed step of "*forming a design for a garden*", as Molnar teaches for example, "specialty gardens" such as "butterfly gardens", "moonlight gardens" or "herb gardens", which could be sold in compact, established form, cut up, and easily installed by the customer (col.-15, line-26 therefrom); whereby forming a design as claimed would be a step inherent to the "specialty gardens" of Molnar.

As to the second step of '*forming pieces*', '*by growing mats of roots*' as claimed: Molnar teaches producing custom, high quality plant sod mats with viable seedlings, root divisions, rooted cuttings or plant plugs for the grower, landscaper and final customer, which give instant beautification and make installation easier for the landscaper or homeowner (col.-14, line-58 therefrom). It is submitted that this teaching of Molnar is consistent with "*forming pieces corresponding to portions of the design by growing mats of roots of respectively different kinds of plants, in accordance with the design, at at least one grower location*", as claimed.

As to the steps of '*harvesting the mats*', '*transporting the mats to a user's garden location*' and '*installing the mats at the user's garden location*' as claimed; those steps are readable on or inherent to the specialty gardens of Molnar, which are sold in compact, established form, cut up and installed as discussed above.

Further, the specialty gardens of Molnar, specifically the cut up mat pieces, by design are intended for placement on and knitting essentially unimpeded into the earth below to form the garden as claimed, as best can be understood by what '*essentially unimpeded*' is meant to convey as recited in the claim.

Regarding **claim-3**:

The discussion above regarding claim-2 is relied upon.

As discussed above Molnar teaches producing custom, high quality plant sod mats with viable seedlings, root divisions, rooted cuttings or plant plugs, whereby the cut up pieces of the mats forming the specialty garden design include members as claimed.

Regarding **claims 4 and 5**:

The discussion above regarding claim-3 is relied upon.

As discussed above Molnar teaches producing custom, high quality plant sod mats with viable seedlings, root divisions, rooted cuttings or plant plugs, whereby the specialty garden designs are capable of including second and third members as claimed. That is, the butterfly garden design of Molnar could include flowering shrub pieces which attract butterflies, in combination with annuals, flowering plants, bushes, wildflowers, grasses and crops known to attract butterflies, as claimed.

Regarding **claims 6-13**:

The discussion above regarding claim-3 is relied upon.

As discussed above Molnar teaches producing custom, high quality plant sod mats with viable seedlings, root divisions, rooted cuttings or plant plugs, whereby the specialty garden designs are capable of including cut up pieces from mats of any number of plant kinds, such as those claimed.

Regarding **claims 14 and 15**:

The discussion above regarding claims 6 and 7 is relied upon.

Molnar teaches in at least example-1 a wildflower sod consisting of North American Wildflower Mix and 10% sheep fescue as claimed.

Regarding **claim-16**:

The discussion above regarding claim-2 is relied upon.

As discussed above Molnar teaches producing custom, high quality plant sod mats with viable seedlings, root divisions, rooted cuttings or plant plugs, whereby the specialty custom garden designs are capable of rendering a corporate logo as claimed, as a corporate logo can be considered a specialty custom garden design, which Molnar teaches.

Regarding new **claims 23 and 24**:

The discussion above regarding claim-2 is relied upon.

Molnar teaches degradable nylon sod reinforcement (matrix as claimed) as a component of the mat and thus cut up pieces of the specialty garden designs as claimed.

Regarding amended **claim-1**:

The discussion above regarding claim-2 is applicable to the instant claim.

As discussed above Molnar '290 teaches production of custom, high quality plant sod mats of many different herbs, vegetables, flowers and groundcovers for the grower, landscaper and final customer (col.-14, line-57 therefrom). Molnar further teaches growing single species of hard-to-establish wildflowers to be installed to form an instant stand of the desired species, and further teaches "specialty gardens" such as "butterfly gardens", "moonlight gardens" or "herb gardens", which could be sold in compact, established form, cut up, and easily installed by the customer (col.-15, line-26 therefrom); whereby forming a design as claimed would be a step inherent to the "specialty gardens" of Molnar, and the resultant sale of the specialty gardens would encompass the transporting and installing steps as claimed. It is submitted that in order for the hard-to-establish wildflower mats to be installed to form an instant stand of the desired species, the mats would have to be capable of knitting essentially unimpeded into the soil below the mats as claimed.

Regarding **claim-17**:

The discussion above regarding claim-1 is relied upon.

As discussed above Molnar teaches producing custom, high quality plant sod mats with viable seedlings, root divisions, rooted cuttings or plant plugs, whereby the specialty custom garden designs are capable of rendering a corporate logo as claimed, as a corporate logo can be considered a specialty custom garden design, which Molnar teaches.

Regarding **claims 18-20**:

The discussion above regarding claim-1 is relied upon.

As discussed above Molnar teaches producing custom, high quality plant sod mats with viable seedlings, root divisions, rooted cuttings or plant plugs, whereby the specialty garden designs are capable of including cut up pieces from mats of any number of plant kinds, such as those claimed. Molnar further teaches in at least example-1, a wildflower sod consisting of North American Wildflower Mix and 10% sheep fescue which would suggest to one of ordinary skill in the art the production of combination mats consisting of multiple different plants or species.

Regarding new **claim-22**:

The discussion above regarding claim-2 is relied upon.

Molnar teaches degradable nylon sod reinforcement (matrix as claimed) as a component of the mat.

Regarding independent method **claim-21**:

The discussions above regarding the independent claims 1 and 2 are applicable to the instant claim. That is, as the examiner considers the recitation of a corporate logo garden as claimed, to be consistent with the Molnar teaching of custom specialty garden designs, that Molnar's specialty gardens would encompass corporate logo garden design, as the custom and specialty horticultural mats of Molnar are sold as segmented pieces for easy installation, and a corporate logo garden or design is no more than individual plant specimens or mat sections to be assembled or planted as a particular design or expression, and in the absence of any claim language that distinguishes between the specialty gardens of Molnar and the claimed logo gardens of the instant invention, Molnar, or rather the specialty gardens of Molnar are capable of rendering corporate logo gardens as broadly claimed.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees.

A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Previously, in the office action mailed 1/11/05, claims 1-15 were rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 25 and 26 of related U.S. Patent No. 6,336,291.

Claims 1-24 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over related claims 1-3 of U.S. Patent No. 6,658,790. Although the conflicting claims are not identical, they are not patentably distinct from each other because the method of making a garden with flowering plants in a sod mat as recited in the conflicting '790 claims encompasses the methods recited in the instant application.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Francis T. Palo whose telephone number is 571-272-6907. The examiner can normally be reached on M-Tu.,Th.-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Mansen can be reached on 571-272-6608. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov.

Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Francis T. Palo/
Primary Examiner
Art Unit 3644